

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEWIS P. WOODSON

Appeal No. 95-1827
Application 07/816,157¹

HEARD: December 11, 1998

Before WINTERS, JOHN D. SMITH, and WALTZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 23, 24 and 29 through 34, which are all of the claims pending in this application.

¹ Application for patent filed December 31, 1991.

According to appellant, the invention is directed to a sterilizer which employs an electrically conductive liquid medium, including a biocide present in a concentration less than that required to eradicate biofilms² and a neutralizer capable of neutralizing any *in situ* electrically generated biocides, and a means to apply an electric field (brief, page 4). Claim 23 is illustrative of the subject matter on appeal and is reproduced below:

23. A sterilizer comprising:

a) an inner cavity containing an electrically conductive liquid medium comprising an effective amount of a biocide, which amount is less than the biofilm biocidal concentration, and an effective amount of neutralizer capable of neutralizing any *in situ* electrically generated biocide; and

b) means for applying an electric field through said medium, the strength of said electric field being equivalent to that generated by an electric current of between 1 and 200 milliamps.

The examiner has relied upon the following reference to support the rejection under §§ 102/103:

Stillman
1988

4,790,923

Dec. 13,

²This concentration is less than the biofilm biocidal concentration (BBC), defined on page 7, lines 28-34, of the specification.

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Claims 23 and 24 stand rejected under 35 U.S.C. § 112,
second paragraph, as being indefinite for failing to
particularly point out and distinctly claim the subject matter
which appellant

regards as his invention (answer, page 3). Claims 29-31 and 34 stand rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim (*id.*). Claims 23, 24, 32 and 33 stand rejected under 35 U.S.C. §§ 102(a) and (b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over Stillman. We reverse all of the examiner's rejections for reasons which follow.

OPINION

A. The Rejections Under 35 U.S.C. § 112

The claims must be analyzed first in order to determine exactly what subject matter they encompass. *In re Angstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976), quoting from *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner has rejected appealed claims 23 and 24 under the second paragraph of § 112 because "[t]he claims improperly recite the material contained within the apparatus as an element of structure." (answer, page 3, referring to Paper No. 13, page 3, dated Feb. 8, 1994). The examiner concludes that

"[t]he material is of an impositive [sic] nature, and is not considered a permanent element of the apparatus structure.", citing *In re Rishoi*³ (*id.*).

However, the legal standard for definiteness under the second paragraph of § 112 is not whether the claims recite a material within an apparatus or whether the material is of an "impositive" or transient nature. "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). There has been no showing on this record by the examiner that one skilled in the art would have any particular difficulty in determining whether a sterilizer apparatus with an electrically conductive medium containing a certain amount of biocide and neutralizer is or is not within the scope of appealed claim 23. The

³ 197 F.2d 342, 345, 94 USPQ 71, 73 (CCPA 1952).

examiner's point, that the claimed recitation of an electrically conductive medium as an element of an apparatus "is material being worked upon by the apparatus" (answer, page 4), has no bearing on the issue of definiteness. *In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

For the foregoing reason, we conclude that the examiner has failed to show that one of ordinary skill in the art would not be reasonably apprised of the scope of appealed claim 23. Accordingly, the rejection of claims 23 and 24 under 35 U.S.C. § 112, second paragraph, is reversed.

The examiner has rejected claims 29-31 and 34 under 35 U.S.C. § 112, fourth paragraph, because of the same line of reasoning, i.e., these claims only recite limitations of the electrically conductive medium and thus do not further limit the apparatus (answer, paragraph bridging pages 4-5). However, the fourth paragraph of § 112 requires that a dependent claim shall "specify a further limitation of the subject matter claimed." See 35 U.S.C. § 112, fourth paragraph (1975). Whether or not the examiner believes the electrically conductive medium is a limitation that affects

the patentability of the apparatus is not the issue. If the dependent claims specify a further limitation of any subject matter claimed in the independent claim, these claims would meet the requirement of the fourth paragraph of § 112. The examiner has failed to show why dependent claims 29-31 and 34 fail to further limit the subject matter of the claims they depend upon.

For the foregoing reason, the rejection of claims 29-31 and 34 under the fourth paragraph of § 112 is reversed.

B. The Rejection over Stillman

Claims 23, 24, 32 and 33 stand rejected under §§ 102(a) and (b) as anticipated by or, in the alternative, under 35 U.S.C.

§ 103 as unpatentable over Stillman (answer, pages 3-4, referring to Paper No. 13 dated Feb. 8, 1994). The examiner states that Stillman discloses an "inner cavity" and "a means for applying an electric field" as required by appealed claim 23 (answer, page 5, and Paper No. 13, page 2). The examiner concludes that the recitation of an electrically conductive medium in appealed claim 23 is "an impositive [sic] element"

of the apparatus and therefore "claims 23-24 recite structure which is either readable on the reference or an obvious modification thereover" (answer, page 5). The examiner cites *In re Rishoi, supra*, for the holding that "there is no patentable combination between a device and the material upon which it works" (Paper No. 13, page 2). The examiner has determined that the "material being claimed as a necessary element of the apparatus combination [the electrically conductive medium] is considered to be the material being worked upon by the structural elements of the claimed apparatus." (Paper No. 13, sentence bridging pages 2-3).

Appellant does not contest that the recitations of "inner cavity" and "means for applying an electric field" are shown by Stillman but argues that the claims are distinguished over the applied prior art by the chemical composition features (brief, pages 7 and 11).

Accordingly, the dispositive issue here is one of claim interpretation, i.e., we must review the examiner's rejection analysis to determine if the claim has been correctly construed as to the scope and meaning of each contested

limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). Every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines. *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970).

Appellant asserts that the electrically conductive medium is positively recited as a necessary element of the sterilizer (brief, page 12). Appellant further submits that the electrically conductive medium must be present in the inner cavity before the sterilizer is complete and operational (brief, page 15). The examiner does not refute these assertions (answer, page 5). The examiner relies upon the asserted holdings of *In re Rishoi* and *Ex parte Masham*⁴ for the determination that there is no patentable combination between a device and the material upon which it works (Paper No. 13, page 2).

There are no *per se* rules for obviousness. *See In re*

⁴ 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987). *See also In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); *In re Young*, 75 F.2d 996, 998, 25 USPQ 69, 71 (CCPA 1935); and *In re Hughes*, 49 F.2d 478, 479, 9 USPQ 223, 224 (CCPA 1931).

Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995). The electrically conductive medium is positively recited in appealed claim 23. As noted above in *In re Wilder*, all positively recited limitations must be given effect. The *Rishoi* and *Masham* cases cited by the examiner are distinguishable by the fact situation in this appeal. These cases dealt with the claimed limitation of a material to be worked upon in combination with an apparatus.⁵ Here the "electrically conductive medium" is an essential part of the operating apparatus and is *not* the material to be worked upon. The material that is being worked upon is the object to be sterilized, e.g., the catheter including a biofilm that requires sterilization. Therefore the examiner's finding that the "electrically conductive medium" of appealed claim 23 is the "material being worked upon" (Paper No. 13, sentence bridging pages 2-3) is in error.

The electrically conductive medium required in the apparatus of appealed claim 23 allows the electric field to have an effect upon the biofilm without the biofilm contacting

⁵ See *In re Rishoi*, 197 F.2d at 345, 94 USPQ at 73.

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the electrodes (specification, page 4, lines 22-31, page 8, lines 31-36, and Figure 4). We see no difference between the type of subject matter here claimed and claims presented to a battery containing an electrolyte (for example, see Class 429/subclass 188 in the *PTO Manual of Classification*).

For the foregoing reasons, we conclude that the examiner has failed to show that all of the limitations of appealed claim 23 are disclosed or suggested by Stillman. Accordingly, the rejection of claims 23, 24, 32, and 33 under 35 U.S.C. §§ 102(a) and (b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over Stillman is reversed.

REVERSED

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| SHERMAN D. WINTERS |) | |
| Administrative Patent Judge |) | |
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| JOHN D. SMITH |) | |
| Administrative Patent Judge |) | APPEALS AND |
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